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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,102	05/04/2001	David Brewer	07316/055003	7965
20985	7590	08/24/2004		
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			EXAMINER WILSON, ROBERT W	
			ART UNIT	PAPER NUMBER
			2661	
DATE MAILED: 08/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,102

Applicant(s)

BREWER ET AL.

Examiner

Robert W Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/4/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/4/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1.0 The application of Brewer et. al. entitled AUTOMATIC ISOLATION IN LOOPS which is a DIV of 09/398,523 9/15/1999 which is a DIV of 09/071,678 5/1/1998 PAT 6,188,668 with filing date 5/4/01. Claim 1 is pending.

Claim Rejections - 35 USC § 103

2.0 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.0 **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Boatwright (U.S. Patent No.: 4,956,836) which is an IDS document of record.

Referring to Claim 1, Boatwright teaches: A fiber channel system ("fiber channel" is not further defined in the claim limitation consequently the examiner gave it no weight because it reflected intended use. Figs 1 & 2 show a system)

A loop comprising a plurality of connected hub ports (The central hub 20 per Fig 1 shows a series of hub ports which are interconnected via the PETAL ISOLATOR which interconnects 1-5 in order to create a loop per Fig 1),

arranged in a loop (Loop per Fig1),

each hub port connected to another hub port (The hub ports are interconnected via the PETAL ISOLATOR per Fig 1),

and a plurality of node ports (1-5 per Fig 1 have node ports),

each node port connected to a corresponding hub port but separated from the loop (The hub ports can be separated or bypassed via the multiplexer shown in Fig 2);

said hub ports each including an error detecting portion which detects an error signal indicative of an error from a corresponding node port (The activity detector and counter per Fig 2

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determine whether the node is active or not and thereby create an error signal when the node is inactive which is sent the multiplexer to bypass the PETAL or node per Figs 1-2)

and a switch (Multiplexer per Fig 2)

said switch being electrically controlled to pass information from said loop through node ports when said node port is operating properly (The multiplexer's bypass control signal is electrically controlled via the ACTIVITY DETECTOR and COUNTER and the multiplexer continues to pass data as long as the node is active per Fig 2)

and to control said switch to bypass said node port when said node port is sending said signal indicative of error (The multiplexer bypasses the PETAL or node upon detection of inactivity per Figs 1-2)

Boatwright does not expressly call for: node sending error signal but teaches that the ACTIVITY DETECTOR and COUNTER per Fig 2 monitor for inactivity.

It would have been obvious to one of ordinary skill in the art at the time of the invention that the monitoring for inactivity by the system of Figs 1-2 performs the same function as a node sending an error signal.

Double Patenting

4.0 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5.0 Claim 1 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,289,002 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: All of the limitations of applicant claim 1 are taught as well as a limitation that the switch is a multiplexer.

The applicant's claim does not expressly call for the switch to be a multiplexer

It would have been obvious to one of ordinary skill in the art at the time of the invention to leave out the limitation of requiring the switch to be a multiplexer in order to create the same invention.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

5.0 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Doerr et al, U.S. Patent No.: 5,625,478 dated April 29, 1997 in which he discloses hub in the central office or local office in which LOCAL WORKSTATIONS or nodes are interconnected in a loop via a first fiber as well as a second fiber. The LOCAL WORKSTATIONS each have SWITCH which allows them to switch rings upon detection of an error.

Pearce et. al., U.S. Patent No.: 5,436,624 dated July 25, 1995 discloses a concentrator or hub which has END STATIONS which are interconnected on a fiber loop. The concentrator or hub

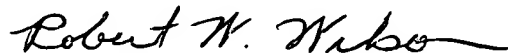
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has a control circuit which monitors for error signals which can cause a end station to be bypassed upon detection of an error.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W Wilson whose telephone number is (703) 305-4102. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms can be reached on (703) 305-4703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Robert W Wilson
Examiner
Art Unit 2661

RWW

August 20, 2004



DANGTON
PRIMARY EXAMINER